

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARY LEE BATES,
PAUL REUBEN DAY and JOHN MATTHEW SANTOSUOSSO

Appeal 2007-2764
Application 09/491,902
Technology Center 2600

Decided: November 26, 2007

Before JOSEPH F. RUGGIERO, ROBERT E. NAPPI
and KEVIN F. TURNER, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1-6, 8-11, 13-16, 18-23, and 25-27. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part and enter a new ground of rejection pursuant to the provisions of 37 C.F.R. § 41.50(b).

STATEMENT OF CASE

Appellants disclose a voice messaging system that uses voice recognition to detect telephone numbers in spoken messages. (Specification

1: 26 – 2:11). The system allows playback to be controlled through those detected telephone numbers. (Specification 4:6-14).

The independent claim 1, which is deemed to be representative, reads as follows:

1. A method of processing a voice message, the method comprising:
 - (a) performing voice recognition on at least a portion of the voice message to generate a textual representation of the voice message;
 - (b) detecting a position of a spoken number in the textual representation of the voice message;
 - (c) determining a playback start position based upon the position of the spoken number;
 - (d) playing the voice message starting at the playback start position; and
 - (e) automatically dialing the spoken number.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Lee	US 5,504,805	Apr. 2, 1996
Eting	US 5,651,056	Jul. 22, 1997

The Examiner rejected claims 1-6, 8-9, 13-16, 18-21, and 25-26 under 35 U.S.C. § 102(b) as being anticipated by Lee. Claims 10, 11, 22, 23 and 27 were rejected under 35 U.S.C. § 102(b) as being anticipated by Eting.

Appellants contend that the Examiner erred in indicating that the claimed subject matter would have been anticipated. More specifically, Appellants have argued that Lee fails to teach determining a playback start position based on a position of a spoken number nor playing the voice message starting at the playback start position. (Br. 5-8). Appellants also contend that Eting does not disclose the automated determination or

detection of whether a spoken number is a telephone number. (Br. 12-14). The Examiner finds that Lee teaches the detection of the spoken number and directs playback at that address and finds that Eting teaches a spoken number recognizer that is operative to recognize a telephone number. (Answer 4-6).

We affirm-in-part.

ISSUES

1) Have Appellants shown that the Examiner has failed to establish that all of the disputed elements of claims 1-6, 8-9, 13-16, 18-21, and 25-26 are taught by Lee?

2) Have Appellants shown that the Examiner has failed to establish that all of the disputed elements of claims 10, 11, 22, 23 and 27 are taught by Eting?

FINDINGS OF FACT

1. Appellants disclose a telephone messaging system that uses voice recognition of at least a portion of a message to provide a textual representation of the message and determine the positions of spoken numbers. Verification of spoken numbers as telephone numbers can occur and textual representations of the determined phone numbers can be displayed. (Specification 4:6-21; Figs. 2 and 3, elements 44, 48, 50 and 80).

2. Based on the locations of the determined phone numbers, the start of playback positioning can be determined and utilized. This allows a user to quickly and efficiently access spoken numbers in the message. The user may also direct playback to previous or subsequent positions in the message

where determined phone numbers were discovered. (Specification 4:6-21; Fig. 6).

3. Lee discloses a system that employs a word recognizer and memory to extract or obtain a phone number from a verbal message left by the calling party. The detected phone number may be displayed or audibly provided to the called party before replaying the message to the called party. The called party can automatically dial the phone number from memory by enabling dialer. (Col. 2, ll. 12-52).

4. The system in Lee maintains a table in RAM to keep track of messages and phone numbers. One column is used to store the beginning and end memory addresses for a voice message stored and another column is used to keep track of the beginning and end addresses that are used to locate a phone number within the memory. Lee does not specify a mechanism to supply the position of detected numbers within the stored voice message. (Col. 3, ll. 12-34).

5. Eting is directed to an accessory device for a telephone system which includes a spoken telephone number recognizer operative to recognize a telephone number spoken in the course of a telephone conversation between a remote communicant and the local communicant. The device also has a telephone number memory operative to store at least one telephone number received from the telephone number recognizer. The device also includes an automatic dialing device operative to retrieve and automatically dial a telephone number stored in the telephone number memory. (Col. 2, ll. 29-33, col. 12, l. 36 – col. 13, l. 59; Fig. 9, elements 1280 and 1320).

6. Eting also discloses that numbers detected can be verified through user involvement. If the telephone number recognizer recognizes a spoken digit, it seeks confirmation of the recognized digit. If the telephone number recognizer recognizes spoken "no" or "clear" words, uttered by a remote communicant in response to digit confirmation, it indicates that the recognized digit was an error. (Col. 14, ll. 16-33).

PRINCIPLES OF LAW

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346, (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful. *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007). “A transitory, propagating signal like Nuijten’s is not a “process, machine, manufacture, or composition of matter.” Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter.” *Id* at 1357.

ANALYSIS

With respect to the first issue, Appellants have argued that Lee fails to teach determining a playback start position based on a position of a spoken number nor playing the voice message starting at the playback start position. We agree, in that there is no disclosure in Lee of obtaining or using a playback start position based upon the position of the spoken number. While Lee identifies numbers in voice messages and stores those numbers, and allows for presentation of identified numbers to the user, (Finding of Fact 3), it does not direct playback of the message using the positions of the identified number within that message. While the Examiner has identified a start position in memory for the identified numbers in Lee, (Finding of Fact 4), that is not the same as the “playback start position” recited in independent claims 1, 13 and 25. We find that Lee fails to anticipate all of the elements of claims 1-6, 8-9, 13-16, 18-21, and 25-26 and reverse the rejection of those claims.

With respect to the second issue, Appellants contend that Eting does not disclose the automated determination or detection of whether a spoken

number is a telephone number. We note that while the Appellants address the automated determination or detection of whether the number is a telephone number, claims 10, 22 and 27 do not provide such specific language. Claim 10 recites merely “determining that the spoken number is a telephone number,” and claims 22 and 27 recite “to detect whether the spoken number is a telephone number.” Eting discloses that numbers detected can be verified through user involvement, (Finding of Fact 6); while the system, by itself, does not necessarily determine whether the detected number fits the format of a telephone number, claims 10, 22 and 27 do not make such a requirement. Since, in Eting, the user and the system verify the propriety of the detected number, we find that this disclosure teaches the disputed elements of claims 10, 22 and 27. With respect to dependent claims 11 and 23, Appellants have not separately argued those claims. As such, we affirm the rejection of claims 10, 11, 22, 23 and 27 as being anticipated by Eting.

NEW GROUND OF REJECTION

We enter the following new rejection of claims 25-27 under the provisions of 37 C.F.R. § 41.50 (b).

Claims 25-27 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 25 and 27 are directed to program products, where one of the elements of those claims is “a signal bearing medium bearing the program.” As discussed above, a transitory, propagating signal is not patentable subject matter under 35 U.S.C. §101. The other limitations of claims 25 and 27

recite programs configured to perform some actions, which are akin to algorithms. Taken together, the limitations are not directed to patentable subject matter. Claim 26 recites that the signal bearing medium includes at least one of a transmission medium and a recordable medium, where the recitation of the former makes clear that claim 26 is directed to non-statutory subject matter.

For the above reasons, we find that claims 25-27 recite non-statutory subject matter. Accordingly, claims 25-27 are rejected under 35 U.S.C. § 101.

CONCLUSION OF LAW

The decision of the Examiner rejecting claims 1-6, 8-9, 13-16, 18-21, 25, and 26 under 35 U.S.C. § 102 based on Lee is reversed. The 35 U.S.C. § 102 rejection of claims 10, 11, 22, 23, and 27 based on Eting is affirmed. Claims 25-27 are newly rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

DECISION

The rejection of claims 1-6, 8-9, 13-16, 18-21, 25, and 26 is reversed and the rejection of claims 10, 11, 22, 23, and 27 is affirmed. A new rejection is raised against claims 25-27.

1 Regarding the affirmed rejection, 37 C.F.R. § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to

37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences

Appeal 2007-2764
Application 09/491,902

for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

KIS

WOOD, HERRON & EVANS, L.L.P.
2700 CAREW TOWER
441 VINE STREET
CINCINNATI, OH 45202